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OFFICE OF PETITIONS

In re Application of :
Maxine C. Thome and Scott P. Thome :
Application No. 09/929,827 :
Filed: August 14, 2001 :
Attorney Docket No. P147.102.101 :
Title: LIGHT GUARD :

DECISION ON PETITION

This is a decision on the petition under 37 C.F.R. §1.78(a)(6), filed June 2, 2003, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of a prior-filed provisional application.

The petition is **DISMISSED**.

On August 14, 2001, the above-identified application was filed without a proper reference to the prior provisional application. Petitioner now wishes to claim benefit of application number 60/225,353, filed August 15, 2000.

A petition for a late claim for benefit under 37 C.F.R. (a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 C.F.R. §1.78(a)(5) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) If the reference required by 35 U.S.C. 119(e) and 37 C.F.R. §1.78(a)(5) of the prior-filed application, unless previously submitted¹
- (2) The surcharge set forth in § 1.17(t); and
- (3) A statement that the entire delay between the date the claim was due under 37 C.F.R. §1.78(a)(2) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

¹ Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed provisional applications must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet – ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number).

With the instant petition, petitioner has included an amendment which inserts a cross-reference to the priority document into the specification of the instant application, the surcharge, and a statement which is being construed as the proper statement of unintentional delay.

Unfortunately, the amendment contains an improper incorporation-by-reference. As set forth in 1268 OG 89:

An incorporation-by-reference statement added after the filing date of an application is not permitted because no new matter can be added to an application after its filing date². If an incorporation-by-reference statement is included in an amendment to the specification to add a benefit claim after the filing date of the application, the amendment would not be proper. When a benefit claim is submitted after the filing of an application, the reference to the prior application cannot include an incorporation-by-reference statement of the prior application³. Therefore, the Office will not grant a petition to accept a benefit claim that includes an incorporation-by-reference statement of a prior application, unless the incorporation-by-reference statement was submitted on filing of the application.

As the amendment contains an incorporation-by-reference statement that was submitted subsequent to the filing of the application, the instant petition cannot be granted.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR §1.78(a)(6)."

The reply to this letter may be submitted by mail⁴, hand-delivery⁵, or facsimile⁶.

The reply should display "Please deliver to Paul Shanoski, c/o Office of Petitions" in a prominent manner.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding *this decision* should be directed to Attorney Paul Shanoski at (703) 305-0011.



Charles Pearson
Director of the Office of Petitions
Office of Petitions
United States Patent and Trademark Office

² See 35 U.S.C. §132(a).

³ See Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980).

⁴ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁵ Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

⁶ (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned.